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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,300	03/12/2004	Atsumi Kobayashi	D-1591	5790

7590            01/19/2007  
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EXAMINER
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NICHOLSON III, LESLIE AUGUST

ART UNIT	PAPER NUMBER
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3651

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/798,300	KOBAYASHI, ATSUMI	
	Examiner Leslie A. Nicholson III	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 October 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 and 10-13 is/are rejected.
- 7) Claim(s) 14 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date. <u>1/16/2007</u>                            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
|   | 6) <input type="checkbox"/> Other: _____.                          |

**DETAILED ACTION**

***Response to Arguments and Amendments***

1. Applicant's arguments filed 6/2/2006 have been fully considered.

Upon further review, the previous rejection of claim 5 as being obvious over Taruki is hereby withdrawn, however, Applicant's arguments are moot in view of the new ground(s) of rejection. See ¶6.

Regarding claim 1, the Examiner respectfully disagrees with the Applicant. The switch back path (20,21) of Taruki turns the document upside down by way of path 20 and reverses a leading and trailing end of the document when transported from path 20 to 21 to 22, and then to the sheet discharging path 22 where the document is guided to the sheet discharging means while turning the document upside down again.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,8 are rejected under 35 U.S.C. 102(b) as being anticipated by Taruki JP 09292742.

Regarding claim 1, Taruki discloses a similar document transport apparatus comprising:

- A sheet feeding tray (5) and a sheet discharging tray (23)
- Sheet feeding means (7) being disposed at one side of the document transport apparatus
- Transport means (16) disposed adjacent to the sheet feeding means
- Sheet discharging means (38) disposed adjacent to the transport means at a side opposite to the sheet feeding means and located at the other side of the document transport apparatus (fig.1)
- A switch back path (20,21) disposed adjacent to the sheet discharging means and located between the transport means and the sheet discharging tray
- A sheet discharging path (22) disposed adjacent to the sheet discharging means

Regarding claim 8, Taruki discloses a similar transport method comprising:

- drawing a document from a sheet feeding tray (5) in a condition such that one edge of the document becomes a leading edge

- transporting the document directly to a predetermined position on a platen (3) in a condition such that said one edge of the document is said leading edge
- guiding the document after one side thereof is read to a switch back path (20,21), said switch back path turning the document upside down, and reversing a leading end and a trailing end of the document
- transporting the document from the switch back path toward a sheet discharging tray (by way of path 22)
- changing a transporting direction of the document before the document is completely discharged to the sheet discharging tray (the direction is changed when it is reversed toward the platen again as is apparent from the abstract)
- guiding the document that the transporting direction is changed to a U turn path (path of 22 to 21 to 24) to transport the document to the predetermined position on the platen again
- transporting the document to the U turn path after the other side of the document is read (abstract)
- discharging the document to the sheet discharging tray (23)
- said switch back path includes a gap (path 40a) so that the document sent into the gap in one direction is sent out in a direction opposite to said one direction

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2,3,4,7,10,11,12,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taruki JP 09292742.

Regarding claims 2,4, and 11, Taruki discloses all the limitations of the claim, but is silent about the apparatus further comprising control means electrically connected to the transport means and the sheet discharging means and wherein the control means controls the transport means and the sheet discharging means.

However, because it is described as an automatic document feeder (title), it is obvious to one of ordinary skill in the art at the time of invention that the automatic document feeder comprises control means electrically connected to transport means and sheet discharging means and wherein the control means controls the transport means and the sheet discharging means.

Regarding claim 3, Taruki discloses the apparatus wherein the discharging tray is located below the sheet feeding tray and above the platen (fig.1).

Regarding claim 7, Taruki further discloses the apparatus wherein the sheet discharging means include a pair of sheet discharging rollers (38) and the discharge path is located between the platen (3) and the pair of sheet discharging rollers and branched from the switch back path (fig.1).

Regarding claim 10, Taruki discloses a similar image reading apparatus comprising a document transport apparatus (1), a platen (3), and reading means (2) (fig.1).

Regarding claim 12, Taruki further discloses the apparatus wherein said switch back path includes a first portion (20) extending to a portion adjacent to the transport means, a second portion (21) extending toward the sheet discharge path, and a gap (24) disposed between the first and second portions (fig.1).

Regarding claim 13, Taruki further discloses the apparatus wherein said sheet discharging path includes a U turn path connecting the first and second portions without passing the gap (abstract) (fig.1).

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taruki JP 09292742 in view of Honjo USP 4,817,933

Taruki discloses all the limitations of the claim and further discloses a guide member disposed at a discharge side of the platen (see figure), but does not disclose the guide member being positioned below the platen when the document is transported from the platen and above the platen when the document is transported to the platen, or switching means connected to the guide member for switching a position of the guide member according to a direction that the document is transported.

Honjo teaches the guide member (25) being positioned below the platen when the document is transported from the platen and above the platen when the document is transported to the platen, and switching means (27) connected to the guide member for

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switching a position of the guide member according to a direction that the document is transported for the purpose of securely guiding the sheet from path to path (C7/L12-25).

At the time of invention it would have been obvious to one having ordinary skill in the art to position the guide member below the platen when the document is transported from the platen and above the platen when the document is transported to the platen, and employ switching means connected to the guide member for switching a position of the guide member according to a direction that the document is transported, as taught by Honjo, in the device of Taruki, for the purpose of securely guiding the sheet from path to path.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taruki JP 09292742 in view of Yano USP 6,467,767.

Taruki discloses all the limitations of the claim but does not disclose the apparatus wherein the switching means includes a torque limiter disposed on a driving shaft of a transporting roller.

Yano teaches a torque limiter disposed on a driving shaft of a transporting roller for the purpose of transmitting a driving force of predetermined torque to the roller (C14/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to have used a torque limiter disposed on a driving shaft of a transporting roller, as taught by Yano, in the device of Taruki, for the purpose of transmitting a driving force of predetermined torque to the roller.

***Allowable Subject Matter***

8. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.N.  
1/16/2006



GENE C. CRAWFORD  
SUPERVISORY PATENT EXAMINER